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PTO/SB/64 (10-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

M1866-25

First named inventor: Toru Kihara et al.

Application No.: 09/556,536

Group Art Unit: 1725

Filed: APRIL 24, 2000

Examiner: C. Shaw

Title: WELDING METHOD OF AN Si-BASED MATERIAL

Attention: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

NOTE: If information or assistance is needed in completing this form, please contact Petitions
Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a
notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the
expiration date of the period set for reply in the Office notice or action plus an extensions of time
actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee --required for all utility and plant applications
filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee \$_____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1280.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of Response to an outstanding Office Action (identify type of reply):

- ☐ has been filed previously on _____.
- ☒ is enclosed herewith.

B. The issue fee of \$_____.

- ☐ has been paid previously on _____.
- ☐ is enclosed herewith.

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 1.0 hour to complete. Time will vary depending upon the needs of the individual case. Any comments on
the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC
20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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MAY 01 2002

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3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c)(III)(C) and (D))].

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

4/18/02

Date



Signature

Telephone
Number: 914 667-6755

Thomas R. Morrison, Esq. Reg. No. 27,361

Typed or printed name

Morrison Law Firm, 145 North Fifth Avenue

Address

Mount Vernon, NY 10550

Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unintentional delay

☒ Other: Complete Response to outstanding Office Action, Declaration of TRM, Explanation of Abandonment, Return Postcard

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

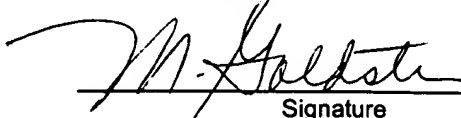
I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

Apr. 18, 2002

Date



Signature

Margaret L. Goldstein

Type or printed name of person signing certificate



1 COPY OF PAPERS
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Toru Kihara et al.
Serial No. : 09/556,536
Filed : April 24, 2000
For : WELDING METHOD OF AN
Si-BASED MATERIAL
Examiner : C. Shaw
Art Unit : 1725
Dcket No. : M1866-25

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OFFICE OF PETITIONS

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents and Trademarks, Washington D.C. 20231 on:

Date: Apr. 18, 2002

By : M.L. GOLDBSTEIN

Signature: *M. L. Goldstein*

EXPLANATION RE ABANDONMENT

Box DAC
Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

1. This explanation is supplemental to the accompanying Declaration of undersigned counsel to provide additional information relating to the abandonment of this application and is submitted as part of the concurrently

filed 37 CFR 1.137(b) petition for the revival of this unintentionally abandoned application.

2. This application is one of the approximate twenty abandoned applications referred to in the accompanying Declaration. The undersigned only became aware of the fact of abandonment of the application in early January of this year.

3. On becoming aware of the abandonment of the application, undersigned counsel found that the office action mailed June 29, 2001 was docketed July 2nd on receipt, and the file given to Lyman Smith who was in charge of and responsible for management of this application. Further examination of the file showed that Mr. Smith did not report the issuance of the action to the client in Japan until October 3, 2001, at which point the original response term already was expired by some days. The client sent Mr. Smith response instructions which were received by facsimile on December 21, 2001. Response could have been prepared and filed by Mr. Smith with a three-month extension, but Mr. Smith did nothing further with the application and, simply, allowed it to become abandoned without the knowledge of others in the office.

Respectfully submitted,



Thomas R. Morrison
Registration No. 27,361
Attorney for Applicant

The Morrison Law Firm
145 North Fifth Avenue
Mount Vernon, New York 10550
(914) 667-6755



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Date: *Apr. 18, 2002*

By : Margaret L. Goldstein

Signature: *M. Goldstein*

DECLARATION OF THOMAS R. MORRISON

Hon. Commissioner of Patents
And Trademarks
Box : DAC
Washington, D.C. 20231

Sir:

Thomas R. Morrison makes this declaration in explanation of the unintentional abandonment of this and other applications in which the Morrison Law Firm is attorney of record, and declares:

1. I am the owner, and sole principal of the Morrison Law Firm (hereinafter MLF). MLF has been in existence since 1984 specializing in intellectual property law with the main practice being patent prosecution before the PTO in behalf of clients, many of whom reside in foreign countries, especially in Japan.

2. In January of 1999, MLF hired Lyman H. Smith as a patent prosecutor. Mr. Smith was educated as a chemist, worked in industry as a researcher and spent two years in the PTO as an examiner in the chemical arts. Mr. Smith is a registered Patent Agent and since August 1999 has been attending evening classes at an area law school. While Mr. Smith was hired mainly for work in chemically related patent matters, it was evident to me within a short time from his hiring that he was a very capable person who could also do work on electrical and mechanical patent cases.

3. In the early days of Mr. Smith's employment, I closely monitored his work and as I did, I found that he had superior skills, was orderly in the manner in which he went about his work, and was well schooled in, and knowledgeable of, the requirements of patent prosecution practice. One result of the confidence and dependability I came to place on Mr. Smith, was my taking him with me to Japan, when I made a business trip to visit with firm clients. Within about nine months after his hiring, Mr. Smith's demonstrated excellent performance established my confidence in him to a degree that I believed he needed but minimum supervision for the prosecution tasks assigned to him.

4. At the beginning of 2001, I informed Mr. Smith of my intention to reduce my work load at MLF, so that after working continuously for sixty-five years, I could spend more time pursuing interests I had had deferred for the

many years I have been involved in building and operating the MLF. I also indicated to Mr. Smith that on his finishing law school and admission to the bar (a date in 2003), I would form a partnership with him and another attorney who has been an associate of MLF since the Summer of 2000, and that after about two years, I would likely withdraw from the firm and fully retire, leaving Mr. Smith and the other associate then continuing as the proprietors of MLF on their own.

5. When I told Mr. Smith of my intentions about the future of MLF, I mentioned that I was reducing my prosecution docket workload, and that he would step in as the primary prosecutor in the office. I also stated that I would remain available to provide advice and would increase my workload if and when Mr. Smith's workload became more than he reasonably could be expected to handle. I also instructed Mr. Smith that he should, and if his workload indicated such was necessary, have recourse to assigning prosecution docket matters to the other office associates. I pointed out to Mr. Smith that the new task he was being given also was an unusual opportunity for Mr. Smith to experience first hand the responsibility and the process of handling the patent prosecution docket of the office. I had no qualms about assigning these further tasks and responsibilities to Mr. Smith. He had a proven record of meeting all obligation and responsibility theretofore given him and I was certain if the new arrangement became too much for Mr. Smith to handle, he would say so since he acted always in professional manner in the office.

6. MLF has for many years used the computer program Patsy for docketing purposes, and the docket is maintained by a paralegal. Office actions issued in applications are entered in the docket system when received from the PTO. The filing of a response to an action commonly would be entered in the docket system by the docket clerk within a day or two from the

date of filing the response. To facilitate checking on the location of files in the office, a bar code reader system reads the identity of files in the file room, attorney offices, bookkeeping, and paralegals offices.

7. Mr. Smith assumed his work under the new task and responsibilities arrangement without any apparent difficulty in the months following my January 2001 meeting with him. Office operation continued with no noticeable difference in its usual daily routine. I continued to work at reduced workload pace but from time to time checked things with Mr. Smith during these months to see how he was doing. At no time did Mr. Smith express any dissatisfaction with his situation or make any mention that he was overburdened with work, or had any problem of any kind regarding his work. During these months, I continued to work with and train the other office associate. I also reminded him to tell Mr. Smith whenever he had a light workload, that he was available if Mr. Smith needed help. This associate mentioned to me that when he had so approached Mr. Smith on a number of occasions, that Mr. Smith advised he had neither work to give nor need of assistance.

8. On a couple of instances in the Summer of 2001, I noted that Mr. Smith had a large number of files in his office and at each of the times, I asked Mr. Smith if he had any problem related to the files and his work. On the first occasion, Mr. Smith assured me that there was nothing amiss and he would take care or anything related to the files. On the second occasion, which was a couple of months later, Mr. Smith assured me that by the beginning of the following week, all matters needing attention in the files would be taken care enough. The following week, I observed that the number of files in Mr. Smith's office was greatly reduced.

9. I had no concern incident the foregoing events that there might be a problem with Mr. Smith's work load or that his attentiveness to docket matters might in any way be changed for the competent manner with which he performed his work in the past. To the contrary, I held Mr. Smith in high regard, I trusted him, and accepted his word that he had taken care of all docket requirements. Again, I note that Mr. Smith gave no hint to me at these times that he was carrying too large a workload or had any kind of problem effecting his performance or interfering with his professional responsibilities.

10. Later in October 2001 when I noticed a new buildup of files in Mr. Smith's office, I instructed the docket clerk to provide me with a status report on all files assigned to Mr. Smith. When the docket clerk indicated to Mr. Smith that she wanted to check his files to obtain status information, Mr. Smith intervened and informed the docket clerk all that outstanding items in the files assigned to him had been taken care of, although some paperwork details remained to be done before he would send the files to the billing paralegal for billing, and later over to the docket clerk for docketing. The reassurance given to the docket clerk by Mr. Smith that he had done whatever was needed in respect of the files assigned to him, must have satisfied me at that time as I still retained trust and confidence in Mr. Smith's word.

11. As I best recollect now, there could have been about the time referred to in the preceding paragraph, or possibly a little later, other mentionings by staff member(s) about Mr. Smith and how he was handling his docket. Since I had not been given any specific information or received any communication from a client that gave substance to what staff members expressed to me, I have to conclude that I must have given benefit of any doubt to Mr. Smith, and still relied on the trust I had in him as being a responsible and reliable professional.

12. On December 21st, MLF had its Christmas party. Mr. Smith did not attend the party. At the party, the firm paralegals and the docket clerk used the occasion as an opportunity to express to me their dissatisfaction with Mr. Smith and what they held to be his uncooperative and evasive dealings with them whenever in the recent months they sought to obtain docket, response and routine information from him regarding the files assigned to him. Further, these staff members expressed their knowledge that cases assigned to Mr. Smith had gone abandoned, and their concerns were directed to the possibility of his dereliction involving a number of applications.

13. At that point and having been given by a number of staff members expressing almost in unison a common serious charge that Mr. Smith's conduct might have seriously effected client rights, I was forced to deal with the thinking that I may have made a mistake about Mr. Smith. This was my first awareness of something credible about Mr. Smith and that he may have disserved firm clients by allowing applications to become abandoned. I ordered the docket clerk to prepare a report on all of Mr. Smith's cases during the period between Christmas and the New Year when I would be absent from the office.

14. On my return to the office following the New Year Holiday, I asked the docket clerk for the report. I learned from the docket clerk that she had prepared the report as instructed including in it a listing of more than twenty of Mr. Smith's case files which could not be physically located anywhere in the MLF spaces. Also, location data on these missing files was not in the bar-code data base. However, the docket clerk could not find the report copy which had been on her desk. It had disappeared.

15. I directed the docket clerk to duplicate the report again in my presence. I went over the report and was greatly disturbed by learning the magnitude of the possible problems associated with the cases assigned to Mr. Smith. While it was clear from the report that some applications had become abandoned, the full scope of what may not have been done for clients could only be learned from reviewing all of the files assigned to Mr. Smith.

16. In addition to what I learned from the report, I received on my return to the office, other disturbing news from the MLF paralegal supervisor. She recounted to me details relating to a case Mr. Smith was handling for one of my British clients. It occurred that some months earlier, this client telephoned Mr. Smith for a status report on a particular case. Apparently Mr. Smith advised the client during the call that an office action had issued, and promised that he would immediately fax the office action to client.

17. Two months had passed and the client telephoned Mr. Smith again since it appears the client never received a copy of the office action. It is understood that Mr. Smith asserted then, that the office action had been faxed to the client immediately following their prior conversation. It also is understood that the client although he had received many other faxes in the normal course of business with our office in the applicable time period, received no copy of the office action. Apparently, Mr. Smith again promised that the office action would be sent by fax.

18. Finally, a third telephone call from the client right after the New Year found Mr. Smith out of the office. With Mr. Smith being unavailable, the client spoke with the paralegal supervisor. The paralegal supervisor learned from the client that the client was still waiting for the copy of the office action.

19. I immediately investigated these assertions of the client and found they pertained to one of the approximately twenty files the docket clerk could not find during her post-Christmas search mentioned above. I directed the docket clerk to go to Mr. Smith and find out if he had that file in his office. Mr. Smith told the docket clerk the file was in his car, parked adjacent the office building. I went to Mr. Smith and demanded he turn the file over to me immediately. With reluctance, he retrieved the file and gave it to me.

20. I examined the file and found no evidence in it of Mr. Smith having reported the office action to the client. There was no letter report copy or facsimile transmission confirmation copy in the file. The application had become abandoned. There is no question in my mind but that Mr. Smith misled the client as to the status of the client's patent application. He also deceived the docket clerk and the paralegal, and as it turned out, me, when further investigation of docket matters uncovered a pattern of concealment by Mr. Smith in failing to report office actions to clients, ignoring client instructions to file responses, make IDS submissions etc, and as it is now known not practicing with truthfulness and candor the professional responsibility required of him.

21. On learning what Mr. Smith had done or more properly, failed to do, I was greatly shaken. This is a young man I came to like and respect very much both as a person and professional. As stated above, I had such regard for him that I proposed in time he would be a successor to ownership of MLF. I have not been able to find out what happened to Mr. Smith or what might have affected his life starting sometime about a year ago that caused and controlled his most uncharacteristic behavior over this period. Even more puzzling to me is Mr. Smith's failure to come to grips with what was a most serious failure by him, and come to me, or any of the other people in MLF, about it so that others

could step in and help carry the load.

22. Unfortunately, Mr. Smith's behavior has resulted in the abandonment of more than twenty client applications placing their intellectual property rights in jeopardy, and this occurring without the clients knowledge and at least in some instances where the clients were misled by Mr. Smith's omissions and false statements.

23. I terminated Mr. Smith on January 14, 2002. Because I had previously learned some files were missing, I retained the services of a private detective to personally and closely supervise the departure of Mr. Smith from MLF, and to ensure that all firm files Mr. Smith has taken to or held extra the firm's premises.

24. The private detective was successful in retrieving a number of files which Mr. Smith had secreted in his car, and hidden in obscure locations within the firm premises including some hidden in Mr. Smith's desk. In the end, all but two of the missing files, both of which were assigned to Mr. Smith, were found. It was necessary to have the firm's local Arlington associate obtain a replacement copy of these two application files from the respective PTO file histories.

25. MLF then turned to completing examination of each and every file assigned to Mr. Smith to ascertain the extent to which problems existed for the clients. It also was necessary to sort through all papers, folders and files in Mr. Smith's office in an effort to assure that no information relating to client files had been misplaced or hidden by Mr. Smith. Considerable items of such were found, and had to be placed in the files to which they relate.

26. As to the work Mr. Smith left undone, responses due in application that remained pending have and are being prepared, and necessary extension requests submitted. Required responses which must accompany the filing of petitions to revive unintentionally abandoned applications have and are being prepared. Some petitions to revive already have been filed and the remainder will be completed and filed in the upcoming weeks. To facilitate this work, MLF had one of its longtime former associates who was in semi-retired status return to work at the firm.

27. As soon as analysis of each file is completed, MLF clients are being informed of the problem, advised that necessary petitions and responses are being prepared for submission to the PTO, and that MLF will pay the petition fees.



Thomas R. Morrison

Dated: 4/18/07